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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,562	03/29/2001	Gilbert Bloch	82017-3700	4962

7590 02/24/2003

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New York, NY 10166-4193

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

12

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS12

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☒ Responsive to communication(s) filed on 12/20/02 and 1/16/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 16-30 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 16-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the Examiner has no recollection of asking applicant to delete his claim 1 preamble language as applicant has done, and notes only that the recitations of intended use were given no patentable significance; it is suggested that applicant reinsert, e.g. --a paper plastic film laminate pressure sensitive sealing tape product--, or similar type language into the claim 16 preamble. Additionally, it is further noted that in claim 16, line 4 "adhesive" should be --pressure sensitive adhesive--, as it initially was and as line 5 of the claim would clearly suggest. In the dependent claims it is noted that claims 20, 22 and 24 utilize apparently contradictory language in his Markush claim structure, i.e. "comprises . . . selected from the group consisting of". Claim 21, upon which claims 22-30 are based, appears confusing in that its recitation that a corona discharge treated surface is "adhesively laminated to the paper layer by a water based adhesive" is believed to read upon only part of the ~~old~~ <sup>cold</sup> lamination techniques claimed in claim 16, and therefore appears to be confusing. In claim 27 the language "item" lacks

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antecedent basis, and it is further noted that the term "unlaminated" is spelled differently in claim 29 as opposed to in claims 25 and 28.

4. Claims 16-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Williams -877 or Williams -971, each taken in view of Ohno et al. substantially for the reasons set forth in paragraph No. 4 of Paper No. 7, together with the following additional observations. Applicant argues strenuously in both his newly entered after final response (page 5, first complete paragraph) ~~and~~ <sup>and</sup> in his newly submitted "letter" that the Finestone et al. patent, U.S. 5,244,702 is not prior art to the applicant. However, the Examiner must respectfully disagree, since this reference, relied upon only for a showing of the state of the art, has not to date been properly distinguished.

Applicant's Cross-Reference to Related Applications section on page 1 of the specification indicates that this application is a continuation of both an issued U.S. patent, which is a CIP of an earlier issued U.S. patent, which itself is a CIP of an abandoned application. To show himself entitled to the filing date of the abandoned CIP, however, applicant must show that the claimed invention as it presently exists is supported by each of the three parent relied upon applications before his arguments that the Finestone et al. patent cannot be relied upon to show evidence of the state of the art can be given any substantive

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weight. Additionally, it is again noted that cold lamination is a product-by-product limitation which has not as yet been shown on the record to produce a patentably distinct article. Finally, the Examiner does make the observation that GB -447 does not disclose that cold lamination was known to one of ordinary skill in the art and as such is not being relied upon to show evidence of the state of the art.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

February 20, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zirker*